



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/677,968

10/01/2003

Katsuhisa Ogawa

B588-656 (25815.672)

9275

26272 7590 07/09/2009
COWAN LIEBOWITZ & LATMAN P.C.
JOHN J TORRENTE
1133 AVE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

CLOUD, JOIYA M

ART UNIT

PAPER NUMBER

2444

MAIL DATE

DELIVERY MODE

07/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/677,968	Applicant(s) OGAWA, KATSUHISA	
	Examiner Joiya M. Cloud	Art Unit 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the communication filed 04/28/2009. Claims 16-20 are PENDING.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/28/2009 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-20, are rejected under 35 U.S.C. 102(b) as being anticipated by Reuss (**U.S. Patent No. 7,376,123 B2**)

As per claim 16, Reuss teaches a service provision method, comprising: acquiring before shipment of a terminal apparatus a host address of the terminal apparatus as connected to a first

Art Unit: 2444

network **(a unique MAC address acquired before shipment, in other words before asset tracking, col. 4, lines 47-61 and col. 7, lines 50-54)**; acquiring owner information of the terminal apparatus **(col. 6, lines 34-44)**; acquiring a network address of the second network in accordance with the acquired owner information acquired at the second acquisition step from a database storing the network address of the second network and the owner information of the terminal apparatus **(col. 7, lines 50-55)**; acquiring after shipment (when the asset is being utilized and desired for tracking) of the terminal apparatus, when a signal is transmitted from the terminal apparatus via the second network, a host address and a network address of a sending side included in the signal; determining the host address of the terminal apparatus acquired before shipment of the terminal apparatus and the acquired network address of the second network to coincide with the host address and the network address acquired after shipment of the terminal apparatus **(col. 7, lines 55-67 and col. 14, lines 11-16)** and of providing a service, via the Internet, to the terminal apparatus via the second network **(col. 9, lines 28-40, where service updates are carried out by center managers)**.

As per claim 17, Reuss teaches a method wherein, in acquiring before shipment of the terminal apparatus the host address of the terminal apparatus, a host address of an terminal apparatus connected to a first network in an apparatus factory is acquired **(col. 4, lines 47-61 and col. 7, lines 50-54)**.

As per claims 18 and 19, Reuss teaches a method wherein, in acquiring the network address of the second network, a part of the network address of the second network is acquired from an Internet service provider for connecting the second network to the Internet and wherein,

Art Unit: 2444

in acquiring the network address of the second network, a part of the network address of the second network is acquired from a DNS server (**col. 8, lines 1-15 and col. 14, lines 56-64**).

As per claim 20, claim 20 is substantially the same as claim 16 and list similar limitations, but in apparatus form rather than method form. Therefore, the rejection for claim 16 applies equally as well to claim 20.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joiya Cloud whose telephone number is 571-270-1146. The examiner can normally be reached Monday to Friday from on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3922.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/677,968

Page 5

Art Unit: 2444

JMC

July 1, 2009

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444